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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,451	05/18/2001	Melvin S. Mogil	100570-00018	5297

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EXAMINER

PASCUA, JES F

ART UNIT PAPER NUMBER

3727

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,451

Applicant(s)

MOGIL, MELVIN S. *ed*

Examiner

Jes F. Pascua

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4 and 19-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 19-24, 28, 29 and 34 is/are rejected.
- 7) ☒ Claim(s) 4, 25-27, 30-33 and 35-44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/323,202.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 3/27/03 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 19-24, 28, 29 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Wyatt.

Wyatt discloses a soft-sided, insulated container comprising first and second insulated container portions 72 that define first and second chambers 82, 84. The first and second insulated chambers are located side-by-side and segregated by an insulated common wall 80. The insulated container portions include an insulated wall structure 74 that is a closure flap and is moveable to close the first and second

openings to the first and second chambers. The first chamber 82 has a fluid container 20 for holding liquids and is releasably attached to the insulated container portion via aperture 86 in the insulated wall structure forming the closure flap 74.

Since Wyatt discloses the insulated container portions being comprised of thermally insulated fabric, the first and second insulated portions of Wyatt are inherently capable of being collapsed. Moreover, due to the inherent collapsibility of the first container portion in Wyatt, the first container portion is also inherently capable of being secured in a collapsed position relative to the common wall.

Furthermore, since Wyatt discloses the insulated container portions that define the first and second chambers as thermally insulated fabric and the common wall as a thermally insulated fabric, the first chamber of Wyatt is inherently capable of maintaining a different environmental condition from the second chamber.

Regarding claim 2, the fluid container 20 of Wyatt meets the claimed structure of applicant's "liner".

Allowable Subject Matter

4. Claims 4, 25-27, 30-33 and 35-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed 10/23/03 have been fully considered but they are not persuasive.

Applicant argues, "There is nothing in Wyatt that indicates that Wyatt's backpack is intended to be collapsible, and there is no indication that it is intended to be secured, or has had provision made for such securement, in a collapsed position." A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, Wyatt discloses the "thermally insulated backpack 70 comprising a plurality of thermally insulated fabric panels 72 that are joined together to form a soft-walled thermally insulated backpack body". The soft-walled thermally insulated backpack body of Wyatt meets applicant's claimed soft-sided insulated container structure and therefore capable of being collapsed. Furthermore, due to the soft-walled nature of the Wyatt thermally insulated backpack body; it is also capable of being secured in a collapsed condition. Straps 90 and 120 could maintain the collapsed condition of the soft-walled thermally insulated backpack body of Wyatt. A claim is anticipated if each element of the claim is found, either expressly described or under

principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice.

Applicant's statement that "[T]he characterisation (sic) of Wyatt's bottle as a 'liner' of the container is, as it was with Strickland, contrived and artificial, and is not an interpretation that is reasonably or fairly borne by the feature shown in the reference" is considered to be opinion. The fluid container 20 of Wyatt meets applicant's structural limitation of being "mounted within its respective chamber". The fluid container 20 of Wyatt also meets the functional recitation "for containing liquids". Furthermore, applicant's characterization of Wyatt's fluid container 20 as a "bottle" is inaccurate. Nowhere in the four corners of the Wyatt patent is the fluid container 20 mentioned as being a bottle. The fluid container 20 of Wyatt is a generic structure for containing fluid mounted within its respective chamber and would encompass any structure for containing fluid mounted within its respective chamber; including applicant's claimed "liner".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., collapsible liner) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Since, applicant's claims do not specifically recite the liner being collapsible while mounted within its respective chamber, there is no "inconsistency of the rejections" as purported by applicant.

As a note, Wyatt discloses that the flexible container 20 is resilient which implies that the fluid container has a degree of flexibility or collapsibility.

Finally, since the Examiner has not introduced a new ground of rejection, applicant is not entitled to a non-final "opportunity to respond" or Office action. See MPEP 706.07(a).

Conclusion


6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 703-308-1153. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.


Jes F. Pascua
Primary Examiner
Art Unit 3727

JFP
January 14, 2004